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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1930.

No. 51.

SARANAC AUTOMATIC MACHINE CORPORATION,

Petitioner.

vs.

WIREBOUNDS PATENTS COMPANY, and 4-ONE BOX MACHINE MAKERS,

Respondents.

PETITIONER'S SUPPLEMENTAL BRIEF.

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To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

May it please the Court:

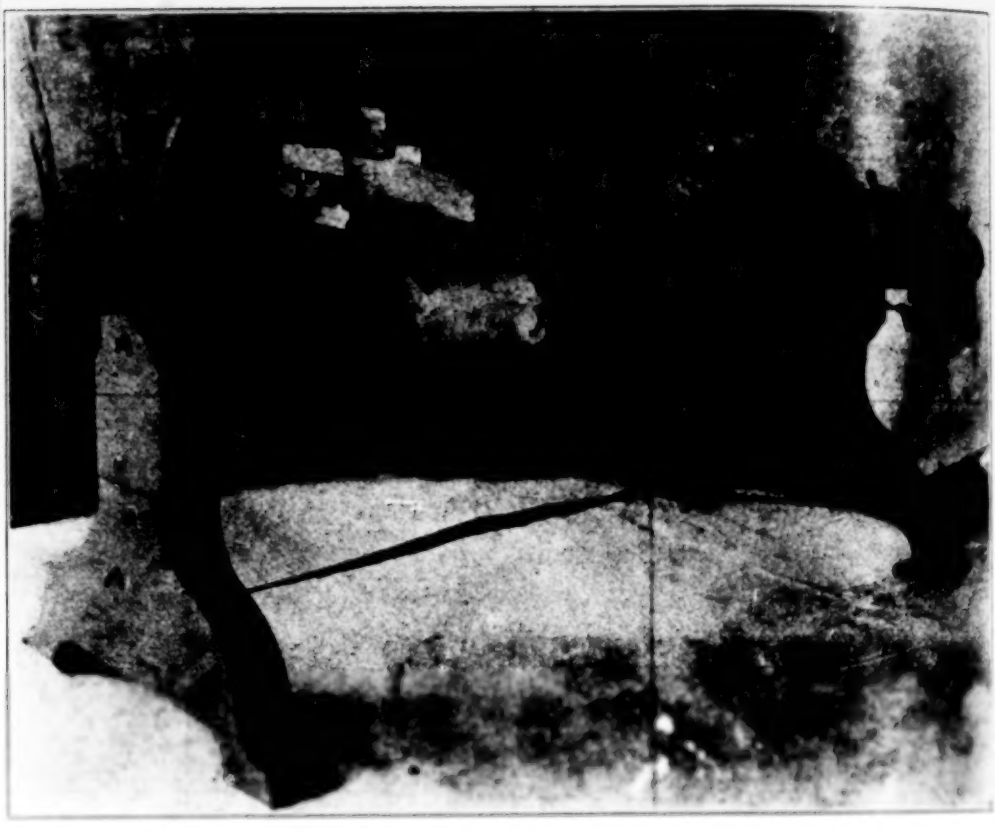
The real defenses in this case have neither been demolished, nor even impaired, by the arguments of respondents' main brief, especially the so-called "Rosback defense." That particular defense is not that the patent in suit is in-

valid because of the prior Rosback patents, but simply that the Rosback teachings have been followed by petitioner; that is, petitioner has simply used the Rosback machine, with such added pushers as were obviously called for to produce the box blank disclosed in the expired reissue box patent. This defense is fully explained in petitioner's main brief.

Respondents "Conclusions" Are Erroneous and Misleading, For It Is Not True That the Patent in Suit Obviates the Necessity of a "Step-Miter" Machine.

Petitioner here answers the assertion on pages 7-22, 30, and 70-72 of respondents' main brief, erroneously made, that Inwood and Lavenberg substituted a single machine for the two machines of the Rosback patents. *This is erroneous, as Inwood and Lavenberg, in the patent in suit, must employ a step-mitering machine, and must employ two machines.* Respondents' arguments are misleading, as they would imply that Inwood and Lavenberg found a way to make one machine do the work of two machines, which is not true.

On pages 94 and 95 of their main brief, respondents, under the heading of "Conclusions," proceed to predicate their entire case upon this erroneous conception, namely, that Inwood and Lavenberg substituted a "*single* machine" for the "*two*-machine practice of the Rosback inventors." By this, respondents obviously mean that the Rosback machinery included not only the blank stapling machine, but also the step-mitering machine or cleat cutter, whereby the cleats were step-mitered and the sheet material was scored; and that Inwood and Lavenberg dispensed with the use of the step-mitering machine. Nothing could be farther from the facts.



This is the "step-miter" machine, or cleat-cutting machine, that would have to be used in combination with the machine of the patent in suit, and which was *actually* used in combination with the "Brown machine," which latter was the nearest approach to the patent in suit (No. 1,128,145), of any machine that was *actually* built and used.

The machine shown opposite this page is one of the step-mitering machines that was used with the so-called "Brown machine," which machine was the nearest approach to anything like the machine of the patent in suit.

No Inwood and Lavenberg guideless machine was made, but it could not operate without a step-mitering machine, as the cleats must be step-mitered before they are put in the portable workholder.

The "Brown machine" has been fully explained in petitioner's main brief, and is referred to on page 1758 of Vol. III of Petitioner's Exhibit 17, Record of the Healy litigation, and the said step-mitering machine shown opposite this page is referred to on page 1760 of said Vol. III.

The machine of the patent in suit, wholly apart from its inoperativeness, could not be used without a step-mitering machine to step-miter the cleats.

Inwood and Lavenberg, in combination with the box blank machine, employed a step-mitering machine, for step-mitering the ends of the cleats. William P. Healy, testifying in the said Healy suit, stated as follows:

> "They did not make any boxes on the Rosback machine before the 5th or 6th or 7th of June, that is, lapped boxes. Of course, he could not use the former on either one, until the step-mitre machine was ready, on either one of those machines, and the former was not ready and the step-mitre machine was not ready until about the 7th day of July, 1904. *They could not use one without the other. In regard to that I take Mr. Inwood as my authority for that.*" (Italics ours.) (Healy Record, Vol. III, p. 1612.)

Inwood himself, in the said Healy suit, testified as follows:

> "Q. I hand you a photograph, being a representation of certain mechanical apparatus, and ask you what it represents.
>
> "A. This is a photograph of a step-miter machine built by the Saranac Machine Company. *It is a ma-*

chine for step-mitering the ends of the cleats before they are attached to the box blank.

"This machine is built by the Saranac Machine Company with the assistance of suggestions by Mr. Lavenberg. The machine is a practically finished machine of which complainant's Exhibit 132 is a rough sketch, with the exception that the work in Exhibit number 132 passed under the saw, while in the machine built by the Saranac Company, the work passed over the saw differently from the manner in which it would do both in Exhibit 132 and Exhibit 172." (Italics ours.) (Exhibit 132 appears at p. 3 of this brief.)

"This machine was built by the Saranac Company, and standing on the floor of its shop, at the time Mr. Wier and Mr. Lavenberg were in St. Joe on the 10th of October, if not in actual working order, it was sufficiently constructed to show what the machine would do when finished." (R., Vol. II, pp. 850-851.)

The cleats had to be step-mitered by some kind of machinery, and the only difference was, very obviously, that Rosback used his box blank stapling machine *first*, and then used the step-mitering machine *last;* whereas, on the other hand, Inwood and Lavenberg used the step-mitering machine *first*, and used the box blank stapling machine *last*. Therefore, the Inwood and Lavenberg practice was a "two-machine practice," just as much as the Rosback practice.

Any wirebound and cleat reinforced blank requires, in the manufacture thereof, two distinct machines, a step-mitering or cleat-cutting machine, and a stapling machine to fasten the wires and sheets to the cleats. That is true of Rosback, is true of the patent in suit, and is true of petitioner's machinery. Petitioner employs tongue-and-groove cleats instead of step-mitered cleats, and respondents' witness, Guilford C. Babcock, on cross-examination, testified that tongue-and-groove cleats, such as petitioner employs, would have to be cut and formed first, on a cleat-tenoning machine, before being run through the box blank machine (R., Vol. I, p. 315).

Petitioner, therefore, does not have a "one-machine practice," but to the contrary has a "two-machine practice," as does any other manufacturer of machinery for making wirebound and cleat reinforced boxes.

As instances of boxes requiring step-mitering or cutting of the cleats *before* they are attached to the box blanks, or to the boxes, prior to the patent in suit, see the following:

Patterson	441,326	(R. 1240)
Howenstine	453,479	(R. 1242)
Ramsey	486,279	(R. 1246)
Fuller	694,467	(R. 1498)
Greenstreet	722,423	(R. 1500)
Walker	767,613	(R. 1510)

Moreover, the use of the step-mitering machine *first*, and of the box blank stapling machine *last*, was an essential part of the expired reissue box patent, granted to Inwood and Lavenberg long prior to the patent in suit, which expired patent (No. 12,725) says:

> "The present [previous] method of manufacturing wirebound boxes is to form the blank of a single sheet stitched or stapled to single piece cleats for each end of the box, the cleats being stepmitered and the sheets scored or grooved on the under side, so as to form four sections, *after* the cleats, sheets and reinforcing wires have been stapled together. This box blank when folded forms a rounding edge, the veneer sheets if not thoroughly seasoned so as to have pliability, begin to check as the lumber seasons. As the grain of the wood may be diagonal to the edge of the box, the check will follow the grain, thus rendering the box unsightly, besides a possible opening of a size so as to preclude its use for goods requiring a tight jointed box." (Italics ours.) (R., p. 1231.)

Obviously, any machinery for practicing the method described in the expired reissue box patent must involve a step-mitering machine for *first* forming the cleats, and a box blank stapling machine for *thereafter* stapling the

cleats and sheets and binding wires together. The proofs show that the Inwood and Lavenberg method was not a "*single* machine" practice, but to the contrary was a "*two*-machine practice," as pointed out in the expired reissue patent, assuming that machinery is used to practice the method described in this patent.

Respondents' conclusions are, therefore, entirely erroneous, and wholly apart from the other reasons pointed out by petitioner, this mistake in itself, which is the false premise of respondents' "Conclusions," is sufficient to justify a decision in petitioner's favor.

Errors and Misleading Statements and New Questions Occur in Respondents' Main Brief.

Respondents have attempted to assume new positions, and raise new issues, and have not only misstated petitioner's defenses, but have misstated the facts, in their main brief. It is thought that a careful reading of petitioner's main brief is a sufficient answer to most of these misstatements and errors, found in respondents' main brief. However, there are some examples of such mistakes, and some new questions raised by respondents, which are here discussed, supplemental to petitioner's main brief, as follows:

Respondents, Apparently Following the Uncertain Language of the Court of Appeals of the Sixth Circuit (the Majority Opinion), Are By Their Arguments Attempting to Convert the Patent in Suit Into a Method Patent, Which, Under the Circumstances, Is Not Possible.

Throughout their main brief (particularly on pages 4, 5, 19, 31, 32, 34, 35, 37, 40, 41, 65, 76 and 95), respondents attempt to point out similarity of *method*, rather than similarity of mechanism, in arguing the question of infringement.

As the court will see, respondents have what they call their method patent, No. 1,128,252. However, the Court of Appeals of the Sixth Circuit refused to find infringement of this patent, although refusing to find that the patent was invalid; but the defenses to this method patent were several.

For one thing, it was not new to pre-form the cleats by cutting them and forming them before they were attached to the box blank materials. (See the prior patents to Howenstine, Hamilton, Healy, Walker, and others, R., Vol. III, pp. 1243, 1233, 1516, 1510, etc.)

Again, Inwood and Lavenberg were guilty of laches in asserting their method claims, for they never made any legal or lawful assertion of such claims, as the record shows, until March 13, 1914 (see Petitioner's Exhibit 15, certified copy of the application for the so-called workholder patent No. 1,128,144, out of which the claims for the so-called method patent were divided). True, on November 2, 1904, after the application for the stapling machine patent in suit was filed, the then attorney for Inwood and Lavenberg attempted to file an amendment asserting method claims, but with no supplemental oath. Such amendment, therefore, was not a legal or lawful assertion of method claims, as required by the law, and could have no force or effect. Moreover, as shown by Petitioner's Exhibit 14 (certified copy of the application for the patent in suit), the attorneys for Inwood and Lavenberg, on January 10, 1905, wrote the Patent Office, asking to have the said amendment cancelled, but that amendment was refused admission, on December 31, 1904, as shown by petitioner's said Exhibit 14, and therefore it was in effect never filed or entered and never cancelled, for there could be no cancellation of an amendment which had never been entered. But, beyond question, petitioner contends, there was an express aban-

donment of the method. Therefore, there was never any valid assertion by Inwood and Lavenberg of method claims, under oath, until March 13, 1914 (see Petitioner's Exhibit 15), and in the meantime intervening rights had accrued, in patents granted to others disclosing the same method (see patents to Miller, R. 1549; Healy, R. 1566; and Craig, R. 1584).

Furthermore, under the doctrine of *Mosler* v. *Mosler* (127 U. S. 354), the method, if any, was in the expired reissue patent No. 12,725 (R., p. 1231), and could not be divided out and made a separate invention in a separate patent. (See also *James* v. *Campbell*, 104 U. S. 356; *Merrill* v. *Yeomans*, 94 U. S. 568; and *Miller* v. *Eagle*, 151 U. S. 186.)

Therefore, the court should guard against being misled into giving the patent in suit any force or effect because of the so-called method of preforming the cleats, or cutting the cleats, before fastening them to the box. The said method patent, originally involved in this suit, was not sustained because of the various defenses, notwithstanding that it was dismissed without prejudice. Because of this, the patent in suit cannot be regarded as in any way covering the method. Discussing this question, Judge Knappen, in his dissenting opinion, said (37 Fed. (2d) 842):

> "It remained for Inwood and Lavenberg to discover that the use of such preformed separate sheets and premitered cleats in machine manufacture was practicable. This use of preformed separate sheets and premitered cleats runs all through the four patents. The contrast between the method of manufacturing wirebound boxes under the patent and the then present method is plainly set up in the reissue patent No. 12,725. The drawings of the patent, in connection with the language of the specifications, clearly indicate the process to be employed in making the product of the patent. The claims of the reissue patent seem to me to indicate plainly to one skilled in the art the process to be employed. As concluded in the original opinion of the Circuit Court of Appeals of the Seventh Circuit in the Gibbons case

(p. 364): 'The entire story of appellees' invention is told in this reissue patent.'"

Respondents are still trying, by misleading arguments, and by subtle indirection, to in effect obtain by adjudication a method patent. But the so-called method patent was dismissed out of the case, and Judge Denison in donig so stated:

> "If we misjudge this situation, and our further consideration of the other claims in suit under any patent is reasonably necessary to settle the controversy between these parties in its present or in any probable modified form, counsel may suggest the necessity and we will give it attention." (37 Fed. (2d) at 841.)

Counsel did *not* file any protest, or any petition for rehearing, and hence have acquiesced in the view that the so-called method (preforming the cleats and thereafter spacing them apart and fastening them to the sheets) is not covered by the one remaining patent (claim 25) here in suit.

Therefore, as a result of the action of the Court of Appeals (majority opinion) of the Sixth Circuit, and the acquiescence of respondents therein, *not only did the method patent disappear from this case, as a basis of recovery by respondents, but also the so-called workholder patent*, for the Court refused to make either one of these two patents the basis of the holding of infringement. This is important, for it should be remembered that it was the said workholder patent application that was divided, *years after that application was filed*, and of which the method patent purports to be a division. There is ample reason, therefore, why the Court cannot predicate any patentability on the so-called method, and cannot predicate any patentability on the so-called workholder, in considering the question of whether claim 25 of the patent in suit is valid and infringed, for by their actions respondents have acquiesced in the contention or view or theory that said claim 25 ex-

presses the only invention involved. Whether the so-called method was patentable, as a separate invention, and whether the so-called workholder was patentable, as a separate invention, are questions that are not before this Court.

There are several reasons why the stapling machine patent here in suit does not and could not cover that method.

1. That method is *old* in the prior art. As pointed out, many old boxes, like Howenstine, Healy, Hamilton, and others, were made by that same method.

2. That method is *essential* in the expired reissue patent (*Mosler* v. *Mosler*).

3. That method is the *subject-matter* of patent No. 1,128,252, which was dismissed out of the case, without protest by respondents.

4. That method is not claimed in the patent here in suit (claim 25), for this patent purports to be for *machinery*, and it is fundamental in law that any method involved cannot be invoked to confer patentable novelty on the machinery.

5. That method was not *adequately* disclosed in the original application of the patent in suit. That is why the so-called method was divided out of patent No. 1,128,144 for the workholder, instead of out of the patent here in suit.

Eulogizing "the method," therefore, cannot avail respondents anything, for by their actions the method has become a closed issue in this case. Because of this fact, the larger portion of respondents' brief and their so-called "Appendix," is entirely irrelevant to the real question of infringement (machine infringement) now before the court.

Respondents Seek to Prove Infringement by Showing That Petitioner Produces the Same Result, i. e., the Box Blank of the Expired Reissue Patent.

A mere glance at petitioner's machine, and at the drawings of respondents' machine patent, shows that mechanically the two machines are fundamentally different. They represent basically different "ideas of means," and we have shown elsewhere why Inwood and Lavenberg made such a radical departure from the Rosback machine.

Infringement is predicated chiefly on the theory that from certain viewpoints, the two machines follow the same sequence of steps; viz., forming the cleats, then assembling them, and then fastening them. Infringement is also predicated on the fact that the ultimate product or result is the same. But this is not sufficient to prove infringement.

As this Court said in *Westinghouse* v. *Boyden*, 170 U. S. 537, 569:

> "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold in other language, that he is entitled to patent his function."

Petitioner's machine, being identical with Rosback's, with the addition of such pushers as are called for by the additional cleats in the blank (which blank is open to the public), surely cannot be said to be the same, or similar means, when compared with the guideless flat top table and portable workholder of the machine patent in suit.

Respondents Have Changed Front Regarding the Old Rosback Box. (See Pages 72, 73, 74 and 75 of Their Brief.)

To sustain their reissue box patent, respondents argued that the Rosback box was a failure. Now, when petitioner shows that Rosback's trouble, fundamentally, was because of his peculiar box, respondents change front and say that the Rosback box was successful.

It *must* have been Rosback's box that was *primarily* at fault, in the use of machinery for making that box. There was nothing inherently wrong with Rosback's stationary cleat guides, endless feed chains, cleat and sheet pushers, and his "hold-backs," as Judge Denison called them, *for petitioner has all of these things and has been using them successfully.* Rosback's theories and the fundamentals of his machinery have been vindicated and demonstrated to be sound and correct in petitioner's machinery.

As showing respondents' previous theory, one illustration will be sufficient. Inwood, while testifying in the Healy litigation, regarding the Rosback creased boxes, criticized them repeatedly, and stated as follows:

> "A. Well, the Rosback box when completed was not a commercial box. It was a box we could not sell." (R., Vol. II, p. 801.)
>
> "A. Well, Mr. Rosback got to South Bend the first of May, and I went out immediately with some boxes that had been made by Mr. Rosback and shipped over with the machine. I took these boxes and solicited orders, and it was during this soliciting that I met with the objections to the box which we were making or trying to make." (R., Vol. II, p. 803.)

Respondents have previously made ample use of the above testimony to prove the validity of their now expired reissue box patent.

If Rosback's *machine* principles and fundamentals (as disclosed in his patents) are wrong, then petitioner's ma-

chine must be equally wrong. Strangely enough, that in effect is what respondents argue. The Rosback *machines* (there is no proof that they were exactly the same as his patents) were bumped around the world, had been in a railroad wreck, and were not a fair criterion by which to judge the *patents* which show petitioner's combination of stationary guides, endless feed chains, cleat pushers and sheet spacers, and hold-backs for the cleats. (R. 460-461 and 715-716.)

On pages 72 and 73 of respondents' brief, they accuse petitioner of wanting to make the old Rosback blank, and of wanting to eliminate the step-miter machine. Petitioner has never made the Rosback blank, and has never tried to make that blank, nor has petitioner ever eliminated the cleat-cutting machine, which would be a step-miter machine when step-mitered cleats are used. Respondents fail to point out in the *record* where they find any basis for these assertions.

Respondents Say (Pages 84-85 of Their Main Brief) That the Guides Which Are Essential in the Brown Patent No. 1,276,484 (R., Vol. III, p. 1611) Were Inadvertently Omitted From or Left Out of the Inwood and Lavenberg Patent in Suit.

This is obviously not correct. In the first place, the Inwood and Lavenberg patent in suit makes specific provision for means to supposedly obviate the necessity of using guides. The long-toothed rollers, "bread rollers" Inwood called them (R., Vol. II, p. 854), would engage the workholder, regardless of lateral displacement of the workholder; but with guides, as in the said Brown patent, rollers are not necessary, and narrow pinions are used instead, as with guides the workholder cannot suffer any lateral displacement.

Again, the affidavit which was filed in the application of the patent in suit, purporting to show that the omission of the guides was an inadvertence, occurred after this application became involved in interference with the application of the Brown patent. (See Petitioner's Exhibit No. 14, certified copy of the application of the patent in suit.) Observing that the Brown application contained the guides, and claims for the guides, Inwood and Lavenberg attempted a ridiculous distortion of the real facts. The Patent Office dealt severely with this palpable misstatement of the facts, and stated as follows:

> "The amendment proposed by Inwood and Lavenberg includes a description, an illustration, and claims, directed to angle-iron guides for guiding the work-holders through the machine. This feature was neither shown, described, nor claimed, when the application was originally filed, and is clearly new matter under the provisions of Rule 70." (See page 86 of Petitioner's Exhibit No. 9, Certified Transcript of Record in Interference No. 27,004, *Healy* v. *Inwood and Lavenberg*.)

Again, respondents' own expert, Arthur S. Browne (erroneously spelled "Brown" in respondents' brief), on cross-examination, testified as follows:

> "X-Q. 77. One of the outstanding features of the stapling machine patent in suit is that it is a guideless machine, isn't it?
>
> "A. Yes. Please look at my answer to X-Q. 57 in the Gibbons suit, already in the record where you ask the same question." (R., Vol. II, p. 669.)

Again, why did Inwood and Lavenberg seek an opinion on the question of infringement, the question of whether the use of guides would infringe William P. Healy's Knudtson and Uhri patent, from the Washington patent attorney named Theodore Dalton, if the guides were inadvertently left out of their patent? The Dalton opinion (R., Vol. I, pp. 456-460) says:

"The question here to be considered is whether or not a certain machine for making box blanks, as made and used by my client, is an infringement of letters patent granted to Thurston L. Knudtson and Jacob Uhri, No. 518,038, dated April 10, 1894.

"At the outset it would be well to explain what constitutes infringement, and it may be stated that infringement of a patent occurs when the thing patented is made or used by others, but as the claims of a patent are the 'metes and bounds' of the grant, it requires an analysis of the claims to determine whether or not the thing made and alleged to infringe is within the scope of the claims of the patented thing, for it is a well settled practice that a patent cannot be construed to include any more than its claims signify, and as a rule the patentee is held to a strict interpretation of his claims, as will appear hereinafter, and this is especially true when the prior art contains devices or machines of similar nature and the patentee was required to limit his claims to the details or specific construction of his particular invention, and particularly when the records of the Patent Office disclose that the patentee was compelled to make such limitations in order to obtain the patent.

"Having stated the general rule for determining infringement, we will now consider the construction of the machine above referred to, in which Mr. R. G. Inwood, of South Bend, Indiana, is interested.

"Mr. Inwood has carefully explained the construction and operation of his machine to me and I have before me photographs of the same. This machine consists, broadly, of a substantially flat table supported on a suitable frame in which are mounted toothed rollers and machines for imparting an intermittent rotation to said rollers, which latter feed the material through the machine, whereby the material is given an intermittent feed, and the feed rollers slightly project through an opening or transverse slot in the table. Mounted above the table are suitable staple forming and driving devices, which are relatively adjustable and which are operated intermittently, and the operating means so arranged as to cause the staple formers and drivers to alternate in their action with the intermittent feed rollers, whereby the material fed beneath

the staple formers and drivers will be at a standstill while the staple is driven therein. Also mounted above the table, are a plurality of wire reels, the wires from which are guided and fed beneath the staple drivers, so that the staple when driven into the material forming the box blank will straddle the said wire, which forms a binding for the box. The box blank consists of cleats which may be either step-mitered at suitable points in their length before they are fed to the machine, or the step mitre may be formed after the blank has been fed through the machine, but the object of the machine is to secure a sheet of veneering and a strengthening or binding wire to the cleats, and in Mr. Inwood's machine; the material of which the box blank is formed to put into a suitable former or frame which has side pieces in which the cleats are clamped, and also has means for holding the sheet of veenering or backing on top of the cleats. On the bottom of the former and preferably upon the lower face of the side pieces thereof, are rack bars which are adapted to engage with the teeth of the feed rollers. The former with the sheets and cleats clamped therein is fed through the machine by the intermittently operating feed rolls, and the staple formers and drivers operated intermittently to drive a staple through the sheets and into the cleats. When the first staple is driven, the binding wire, which is fed from the wire reels, is engaged by the staple and then by the continued feed of the former through the machine, the wires are drawn from their reels and engaged by the staples. A suitable guiding means for the strengthening wires is provided adjacent to each staple driver. The box, when completed, is quite similar to the box shown in the patent to Howenstein, No. 453,479, dated June 2, 1891, except that the strengthening wires are adjacent to the cleats and the staples penetrate the cleats as well as the sheet. It is to be noted that this machine has a flat table so that the former carrying the box blanks will be unobstructed in its movement through the machine, and it is also to be noted that the cleats do not slide in or have any movement independent of the former, as the cleats are clamped in the former.

"The construction and operation of the Knudtson & Uhri patent is plain from an examination of the copy

herewith attached, and inasmuch as an infringement results when the defendant employs the elements or equivalents of the elements claimed in the patent for substantially the same purpose and with substantially the same result, we must now examine the claims of the Knudtson & Uhri patent.

"Claim 1 recites:

> " '1. In a machine for forming box blanks by fastening the sheets and strengthening wires to reinforcing cleats, the combination of guides for the cleats, intermittent feed mechanism for advancing the cleats longitudinally in their guides and with a sheet through the machine, an intermittently actuated staple driver adjacent to the path of each cleat alternating in its action with said feed mechanism, to fasten the sheet, by successive operations, to the cleat; and means for guiding strengthening wires with the cleats and sheet across the staple drivers, substantially as and for the purpose set forth.'

"This claim is probably the broadest claim in the patent, and if we find that it is not infringed, obviously the other claims would not be infringed, because the other claims in addition to reciting the elements contained in the first claim, include other elements and qualifications of those elements.

"*The first element 'guides for the cleats,' is not present in the machine manufactured or used by Mr. Inwood*, because, as before stated, the table on which the former with the box blank is placed, has no guides whatever, and the cleats are not guided through the machine mechanically. The 'intermittent feed mechanism for advancing the cleats longitudinally' is used, inasmuch as the toothed feed rollers are driven intermittently and they advance the cleats longitudinally, mediately, through the advancement of the former, which engages with the teeth of the rollers, but there is no intermittent feed mechanism for advancing the cleats longitudinally in their guides, *because there are no guides*. The cleats are advanced longitudinally with a sheet through the machine, *but not in guides*. The next element of the claim, and the operation thereof, namely, 'an intermittently actuated staple driver adjacent to the path of each cleat alternating in

its action with said feed mechanism, to fasten the sheet, by successive operations, to the cleat' is employed and practiced in the Inwood machine. The next and last element of the claim, namely, 'and means for guiding strengthening wires with the cleats and sheet across the staple drivers' is also used in the Inwood machine, inasmuch as he employs a small roller in front of the staple drivers around which the strengthening wire is fed and guided." (R. 456-460.) (Italics ours.)

Furthermore, in the suit of *William P. Healy* v. *Inwood and Lavenberg et al.* (Petitioner's Exhibit 17), Inwood testified that the patent in suit was for a guideless machine. He said:

"The machine cannot be operated without guides and I know this to be true for the reason that we have a claim in a patent allowed on a machine similar to the Brown machine, except that it has no guides, and the drawings which were submitted to Mr. Dalton and upon which he based his opinion was a machine without guides, and the construction of the machine was such that the only movement imparted to the former in feeding through was given by a roller extending across the machine, shaped like, a little like a bread roller except that on its surface it had raised parts and depressions extending the length of the roller, corresponding somewhat to the gear-wheel on the Brown machine, so that *there was no necessity of the use of a guide*, as the roller would engage the former at whatever part of the machine or table the former was placed and the angle iron spoken of by Mr. Healy were entirely missing. The table was perfectly smooth, containing nothing in any way to act as a guide to the former. In the construction of the upper part of the machine mechanism was employed which would place the staples in their proper position on the blank." (R., Vol. II, p. 854.) (Italics ours.)

In addition, the Inwood and Lavenberg application itself, for the patent in suit, when originally filed, contained the following language, which was obviously no inadvertence:

"It is one of the objects of the present invention to provide an improved feed mechanism for this former or carriage and to *dispense with the use of guides for the blank*, whereby the former with the blank therein will have an unobstructed path through the machine." (Italics ours.) (See Petitioner's Exhibit 14.)

Petitioner admits that the guideless machine of the patent in suit was a fallacy, but that does not make it an inadvertence, for, fallacy or no fallacy, it was deliberate and intentional.

Respondents, on page 86 of their main brief, state that petitioner's expert witness, John Howard McElroy, said that the inoperativeness of the Inwood and Lavenberg patent in suit could be cured by mere mechanical skill. That is not correct, for the witness merely indicated that, in his opinion, a *machine* of this kind could be made operative by a mechanic entirely familiar with the prior art, by mere mechanical skill. That, however, is quite different from saying that the *patent* in suit can be made operative by mere mechanical skill, for no matter what a physical machine might be, the fact remains that the patent in suit is not only mechanically inoperative, *but is also legally inoperative*, because the mechanical inoperativeness is a part of the alleged invention or novelty of the disclosure. As has been shown, leaving off the guides in the *patent* was a part of the theory of the invention, as Inwood said in his testimony, as the witness Arthur S. Browne said, as the Dalton opinion says, and as the application of the patent in suit stated when filed. (See R., Vol. II, p. 854; Vol. II, p. 669; Vol. I, pp. 456-460; and Petitioner's Exhibit 14.) The Patent Office took this view, refused to let Inwood and Lavenberg change the theory of their invention, and followed this by granting a separate patent, the Brown patent (R., Vol. III, p. 1611), containing claims for the guides that respondents try to say were inadvertently omitted in the patent in suit.

Respondents Say (on Page 77 of Their Main Brief) That Inwood and Lavenberg Did Not Need to Worry About the Question of Infringement When They Designed Their Machine, Inasmuch as They Were Then on Good Terms With William P. Healy, the Man for Whom They Were Working.

This is not correct, and is contrary to the real facts, as follows:

First, it is true that Inwood and Lavenberg were *pretending* to be friendly with Healy, at that time, but secretly they were plotting against him. On October 7, 1904, they organized their rival company (Healy Record, Vol. I, p. 200, Petitioner's Exhibit 17). If they were not worried about the question of infringement, should they use guides on machines to be put out by their new company, in which Healy was to have no interest, why did they go to Theodore Dalton and get an opinion to the effect that if they did not use guides they would not infringe Healy's Knudtson and Uhri patent (see pages 31-34 of Petitioner's Main Brief; also R., Vol. I, pp. 456-460).

The first "Brown machine" having the guides (see Brown patent No. 1,276,484, R., Vol. III, p. 1611; and Healy Record, Vol. III, p. 1758) was William P. Healy's property (R. 706) and arrived at South Bend on August 31, 1904 (R. 453), which was long prior to the filing of the application for the Inwood and Lavenberg patent in suit.

It was on September 22, 1904, that Inwood went to Washington to obtain the Dalton opinion showing non-infringement of Healy's patents (R. 453). It was some time *after* that, on October 27, 1904, that Inwood and Lavenberg filed their application for the patent in suit. Obviously, their anxiety was to make application for a patent for a machine that would not infringe Healy's

patents. Hence the guides were intentionally and deliberately omitted from the application.

In the face of all this, it is futile and disingenuous for respondents to try to argue that Inwood and Lavenberg were not seeking to avoid infringement of Healy's patents, by omitting the necessary guides in their application for the patent in suit, and that these guides were inadvertently left out of the patent.

On page 84 of their main brief, in the first paragraph, respondents say "long after the Inwood and Lavenberg machine had been ordered and in course of construction," but this is obviously a misstatement. No "Inwood and Lavenberg *machine*" was ever ordered or built or used. The first and only machine using portable traveling workholders was the "Brown machine," which was delivered to the South Bend Healy Box Company on August 31, 1904 (R. 453). The "Brown machine" was Healy's property. But Inwood and Lavenberg filed their application for the patent in suit, secretly, without advising Healy, and Healy did not discover this until some time later (Healy Record, Vol. I, p. 21, Petitioner's Exhibit 17).

Respondents Assert, on Page 79 of Their Main Brief, That the Machine of the Patent in Suit Will Operate Without Stopping Between Blanks.

Petitioner has discussed this in its main brief, but respondents have replied by pointing to the *new matter* which was inserted in the Inwood and Lavenberg application after it was filed, arguing that tis new matter calls for a machine which does not stop between blanks.

Petitioner points out, however, that the new matter inserted cannot have any such meaning, that the described operation of the machine makes it impossible to run the machine without stopping between blanks. This new mat-

ter was inserted June 1, 1905 (see Petitioner's Exhibit 14, certified copy of the application of the patent in suit), in an application in which the machine had already been shown and described as necessarily stopping between blanks, or after each blank is finished. For the reasons pointed out on page 13 of petitioner's main brief, the machine of the patent in suit cannot operate without stopping between blanks, and must stop after each blank is finished.

But just why are respondents so anxious to assert, erroneously, that the machine of the patent in suit can operate without stopping between blanks? There is nothing about this in claim 25 of the patent in suit. Both respondents and the Court of Appeals of the Sixth Circuit have discussed this question, but no infringement could be predicated upon this feature, even if it were present in the disclosure of the patent in suit, which is not the case, as this feature is not in claim 25 of the patent in suit.

Respondents Misstate the Facts and Seek to Distort the Defenses.

As an example of this, respondents say, on page 41 of their brief:

> "In the face of such findings as these, and of the testimony recently discussed, it seems incredible that the Inwood and Lavenberg machine could have been considered an obvious expedient emerging from the unsuccessful groping of the Rosback inventors who, during ten years, never produced practicable machines and were unable, for lack of adequate machines, to establish any business in wirebound boxes. The instant success of the Inwood and Lavenberg machine and the rapid growth of the industry founded thereon preclude any possible suppositions that their accomplishment was merely that of mechanics."

In the first place, there never was an "Inwood and Lavenberg *machine*," for no machine like the patent in suit

was ever built or used. The nearest approach to it was the so-called Brown machine (R., pp. 706 and 1611). It was called the "Brown machine" because this machine was designed by Norman E. Brown, patentee of patent No. 1,276,484, granted August 20, 1918 (R., p. 1611), and the fact that this patent was granted shows that Brown invented something, so the Patent Office thought, and that the invention was the provision of guides on the machine, to properly guide the cleats and sheets through the machine, as distinguished from the guideless machine of the patent in suit.

In the next place, no one has ever said that the specific machine of the patent in suit was "an obvious expedient," for to the contrary it was the most *unobvious* thing that could be imagined. The "obvious expedient" for making the box blank of the expired Inwood and Lavenberg reissue patent was the Rosback machine with the requisite number of cleat pushers. But Inwood and Lavenberg didn't want to use the stationary cleat guides of the Rosback patents, and the endless chains and cleat pushers of the Rosback patents, for several reasons:

First, they were afraid of infringement of the patents owned by William P. Healy, particularly the Knudtson and Uhri patent. The "Brown machine" could use the guides, because this machine was Healy's property. But the application for the patent in suit was filed surreptitiously, without Healy's knowledge (Healy Record, Vol. I, p. 21, Petitioner's Exhibit 17), and did not become Healy's property until years afterward. Hence, in the patent in suit, which for a long time Inwood and Lavenberg contended was their own property, or the property of their company, the National Wire Bound Box Company, they left off the guides to escape at least the appearance of any infringement of any of Healy's patents.

Second, Inwood and Lavenberg had the fallacious idea that portable workholders were faster and more efficient than endless chain feed. They were not the first to stumble into that error, for others had done the same thing. See the first patent to Fuller, No. 690,416, granted January 7, 1902 (R., Vol. III, p. 1491), using portable workholders, and then observe the subsequent patent to Fuller, No. 694-467, granted March 4, 1902 (R., Vol. III, p. 1498), using endless chain feed.

As a matter of fact, it does not make much difference what Inwood and Lavenberg's motives were for not using the Rosback stationary cleat guides, endless feed chains, cleat pushers and sheet pushers, and stationary springs or holdbacks for frictionally engaging the sides of the cleats. That does not matter very much, although their motives were clear. The fact remains that petitioner is using the said Rosback combination. This combination is susceptible of as wide and diversified use as any other blank machine, and is susceptible of use for the making of different kinds of blanks, without going outside of the teachings of these Rosback patents.

That Inwood and Lavenberg's portable workholder and guideless stapling machine was a stupid idea, and was a fallacy, is manifest from the fact that nobody ever tried to use a machine of this kind. Moreover, the said Brown machine, which was the nearest approach to the patent in suit, never went any farther than merely one or two machines, for the hundreds of other machines employed by respondents were of a totally different type.

The effort to stretch the patent in suit, in order to make it cover petitioner's machine, which latter is nothing more than the machinery of the Rosback patents with the cleat pushers adjusted in number to correspond with the obvious requirements of a different kind of blank, is preposterous.

Again, respondents, on page 41 of their brief, quote from the opinion of Judge Lindley, as follows:

> "It was the patentee's fundamental difference in the order of assembly and methods of construction that contributed most to the invention over Rosback."

Obviously, Judge Lindley was talking about the construction of the box blank and box, not the construction of the machinery. Judge Lindley found that the "order of assembly and methods of construction" were all in the expired reissue box patent, for he said:

> "We are of the opinion, however, that the entire story of the appellee's invention is told in this reissue patent, and that the solutions of the problems demonstrated in the other three patents were obvious, and involved the exercise of merely ordinary mechanical skill." (25 Fed. (2d) 364.)

On pages 16, 20, 21 and 25 respondents again misstate the facts and make misleading statements. If Inwood and Lavenberg "created a new industry," the invention responsible therefor was in the *box* of the expired reissue patent, and not in any machine invented by Inwood and Lavenberg. The machine of the patent in suit was never used, and therefore it was not "the very first machine capable of commercial production of wirebound boxes," for the so-called "Brown machine" (R. 453) was the first portable workholder machine to produce the box blank of the expired reissue patent.

Moreover, Judge Raymond dismissed the three patents in suit for want of equity, holding that the method, if any, was in the expired reissue box patent.

On page 30, respondents say that "Petitioner makes no claim that the Inwood and Lavenberg machine, or its equivalent, was ever known or used in the prior art." *This is true, if respondents mean the machine of the patent in suit, for it has been said repeatedly that no such machine was*

ever made or used, throughout the entire history of the wirebound box machine art. What petitioner does say is that its own machine, to the extent of stationary cleat guides, endless feed chains, traveling cleat pushers and sheet pushers, and stationary springs or holdbacks for frictionally engaging the sides of the cleats, was well-known in the Rosback and other patents. It does not matter whether the machine of the patent in suit was known previously or not, for petitioner does not use this machine, and no one else ever used it or tried to use it.

On pages 70, 71 and 72, respondents vociferously assert that it was Inwood and Lavenberg who taught petitioner everything that the latter uses. This needs no further contradiction, except to again point to the questions and answers in the testimony of Arthur S. Browne (erroneously spelled "Brown" in respondents' brief), showing that practically everything that petitioner has was obtained from the Rosback patents (R., Vol. I, pp. 425-433).

On pages 77 and 78, respondents naively challenge petitioner to explain why Rosback did not use preformed cleats in the manufacture of his blanks. This is a question that answers itself, but petitioner will again say that Rosback employed a peculiar construction for his box, which construction precluded the use of preformed cleats. Rosback used a continuous sheet of veneer, scored on its under side, but when separate sheets were proposed, for the different sides of the box, as Inwood and Lavenberg disclosed in their first patent (the expired reissue box patent), it then became obvious that preformed cleats could be used.

But preforming the cleats was not new with Inwood and Lavenberg, as shown by the prior patents to Howenstine, Healy, Hamilton, Archer and others (R., Vol. III, pp. 1233, 1243, 1516; and p. 1879 of Transcript of Record on appeal in Gibbons suit, Petitioner's Exhibit 17).

Petitioner will not attempt to schedule all of the mistakes

and misleading statements in respondents' brief and so-called "Appendix," for the above, and some others commented on elsewhere, particularly the statement that Inwood and Lavenberg substituted a "one-machine practice" for a "two-machine practice" (incorrect on the face of the statement), will be sufficient to illustrate the character of the arguments being asserted by respondents in their attempt to make the court believe that petitioner is arguing that the Rosback patents are an anticipation of the specific portable workholder and guideless stapling machine combination of the patent in suit.

To the contrary, petitioner says that respondents may have their patent for the only novelty disclosed in the patent in suit, the combination of the specific portable workholder with the guideless stapling machine. That is all respondents are entitled to, is a fair estimate of the most for which the patent in suit can be valid, and does not cover petitioner's machinery. This, of course, wholly apart from the other defense that the patent in suit is invalid because for a legally inoperative mechanical disclosure.

Conclusions From First Reading Petitioner's Main Brief, Then Respondents' Brief and Appendix, and Finally This Supplemental Brief.

1. Whether the patent in suit is valid or invalid is of no importance, so far as the *real* question of infringement is concerned. That question is whether petitioner uses (*a*) *the cleat spacer and portable workholder system* of the patent in suit, or uses (*b*) *the endless feed chain and stationary cleat guide and traveling cleat pusher system* of the Rosback patents. Respondents have failed to show that petitioner has gone outside of the teachings of the Rosback and other patents. It would be a stupid mechanic that could not count the cleats on a blank and then provide

Rosback pushers accordingly. It would be less than mechanical skill that would balk at the problem.

2. Petitioner's cleat pushers are structurally and functionally the same as those of the Rosback patents.

3. Any method (preforming the cleats) involved in the patent in suit is *not* a part of claim 25, but is an essential part of the expired reissue patent.

4. Respondents' voluminous arguments about the difference between a "two-machine practice" and a "one-machine practice" are erroneous and based on an oversight, for the patent in suit contemplates, necessarily, the use of two machines, one to step-miter the cleats, and one to staple the cleats to the sheets. Rosback, the patent in suit, and petitioner, all contemplate the use of two such machines. Otherwise, how are the cleats step-mitered, as in the patent in suit, or cut with tongue and groove ends, as practiced by petitioner? Respondents apparently forget that a step-mitering machine, or cleat-cutting machine of some kind, is necessary in every known method of making cleated wirebound boxes.

5. There are no stationary cleat guides in the patent in suit. Petitioner took these from the Rosback patents.

6. There are no endless feed chains in the patent in suit. Petitioner got these out of the Rosback patents.

7. There are no cleat pushers in the patent in suit. Petitioner appropriated these from the Rosback patents.

8. There are no stationary springs or "hold-backs" to frictionally engage oncoming cleats in the patent in suit. Petitioner obtained these from the Rosback patents.

9. There are no sheet spacers in the patent in suit. Petitioner learned this sheet spacing practice from the Lipps and Springer and Greenstreet patents.

10. There are no *moving* work controlling and feeding means, into the path of which the cleats and sheets are tossed and dropped, in the patent in suit. Petitioner took

this from the prior art, not from the patent in suit. The difference is *fundamental,* for in petitioner's machine it is like throwing the cleats and sheets into a *flowing* stream, while in the patent in suit the cleats and sheets are assembled on a then *stationary* workholder. In petitioner's machine, the box blank is assembled while moving along, for the machine does not stop between blanks. In the patent in suit, the portable workholder must be stopped, after being fed through the machine, laid on a table or bench to receive a new assembly of cleats and sheets, and then carried to the stapling machine again. In the patent in suit, regardless of any fictitious arguments to the contrary, the work feeding means must stop after each blank is finished. In petitioner's machine, the work feeding means are never taken out of the machine but run constantly (without stopping after each blank is finished), as in Greenstreet, Lipps and Springer, and others.

11. The cleat pushers of Rosback are *necessarily* positioning devices, for they position the cleats on the under side of the box blank, with the *thereafter* step-mitered end portions of the cleats in predetermined relation. If it were not for the *positioning* function of Rosback's cleat pushers, his cleats would be displaced endwise by the stationary springs or "hold-backs" that frictionally engage the sides of the moving cleats. It was obviously error for the court (Judge Denison) to hold otherwise. The dissenting opinion (Judge Knappen) is correct.

12. Even if petitioner's cleat pushers, because of the greater number, function differently from those of Rosback (which has not been shown), such difference is not because of any difference in *machinery,* structurally, as petitioner's pushers are structurally the same as Rosback's pushers, but simply because petitioner's *blank* is different from Rosback's blank.

13. Inwood and Lavenberg, in the patent in suit, avoided

using the stationary guides, the endless feed chains, the cleat pushers, the sheet pushers, and the stationary springs or "hold-backs" for frictionally engaging the sides of the cleats, *because they were afraid of infringement of the Knudtson and Uhri patent owned by Healy at that time.* The Dalton opinion (R., Vol. I, pp. 456-460; printed at pp. 15-18 of this brief), the Master's Report (Healy Record, Vol. I, pp. 137-220), and the entire record in the Healy litigation (Petitioner's Exhibit 17) show that this was the reason why the guides and other things employed by Rosback, and now employed by petitioner, were not used in the patent in suit.

14. Respondents *cannot* have a method patent adjudication here. They have argued the case as though the invention was a method, and there is much confusion of thought in their brief. But the method is *not* an element of this case, for the method went out of the case when the court dismissed the method patent without any protest or petition for rehearing by respondents.

15. There is no infringement for the reasons stated by both courts of the Seventh Circuit, by the District Court of the Sixth Circuit, and by the dissenting opinion of the Court of Appeals of the Sixth Circuit. This is not one of those cases in which the weight of authority in one circuit is evenly balanced against the weight of authority in another circuit. To the contrary, this is a case in which the Judges of one circuit are evenly divided on the question of infringement, while the Judges of another circuit are unanimous in holding no infringement.

Respectfully submitted,

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